

**REMARKS**

Claims 1, 7, 8, 12, 18 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Cassagnol et al.* (U.S. Patent 6,438,666) ("Cassagnol") in view of *Banker et al.* (U.S. Patent 6,005,938) ("Banker"). Claims 9, 10, 20, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cassagnol and Banker as applied to claims 1 and 12 above, and further in view of *Dillaway et al.* (U.S. Patent 5,742,756) ("Dillaway"). Claims 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cassagnol and *Lohstroh et al.* (U.S. Patent 5,768,373) ("Lohstroh") as applied to claims 1 and 12 above, and further in view of *Kruys* (U.S. Patent 5,555,309) ("Kruys"). Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

Independent claims 1 and 12 include: ...providing a first data processing system for a first user including the first user's private key and a master private key; providing a second data processing system for a second user including program instructions and the first user's public key and master public key to generate a session key, to encrypt original data using the session key, to encrypt the session key with the first user's public key, to encrypt the session key with the master public key, to generate a first data packet including a plurality of encrypted session keys and encrypted data, and to transmit the first data packet to one or more different data processing systems instead of or in addition to the first data processing system; and the first data processing system receiving the first data packet and including program instructions to decrypt one of the encrypted session keys with the private key of the first user, and to decrypt the encrypted data with the session key to re-create the original data.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a

whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach providing a first data processing system for a first user including the first user's private key and a master private key; providing a second data processing system for a second user including program instructions and the first user's public key and master public key to generate a session key, to encrypt original data using the session key, to encrypt the session key with the first user's public key, to encrypt the session key with the master public key, to generate a first data packet including a plurality of encrypted session keys and encrypted data, and to transmit the first data packet to one or more different data processing systems instead of or in addition to the first data processing system; and the first data processing system receiving the first data packet and including program instructions to decrypt one of the encrypted session keys with the private key of the first user, and to decrypt the encrypted data with the session key to re-create the original data.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ... [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because neither teaches or suggests providing a first data processing system for a first user including the first user's private key and a master private key; providing a second data processing system for a second user including program instructions and the first user's public key and master public key to generate a session key, to encrypt original data using the session key, to encrypt the session key with the first user's public key, to encrypt the session key with the master public key, to generate a first data packet including a plurality of encrypted session keys and encrypted data, and to transmit the first data packet to one or more different data processing systems instead of or in addition to the first data processing system; and the first data processing system receiving the first data packet and including program instructions to decrypt one of the encrypted session keys with the private key of the first user, and to decrypt the encrypted data with the session key to re-create the original data.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

In view of all of the above, the allowance of claims 1, 7-12 and 18-22 is respectfully requested.

**PATENT**

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The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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on

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